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APPLICATION NO. 09/443,763	FILING DATE 11/26/99	FIRST NAMED INVENTOR LEE	ATTORNEY DOCKET NO. 102306.09
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EXAMINER SIRCUS, B

ART UNIT 2839	PAPER NUMBER
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DATE MAILED: 06/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/449,763

Applicant(s)
Lee

Examiner
Brian Sircus

Group Art Unit
2839



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The disclosure is objected to because of the following informalities:

There are repetitive references to the parent applications throughout the specification. These should be removed from the brief description of the drawings and from the detailed description. The brief discussion of the origins of this application may be placed after the summary of the invention and before the brief description of the drawings.

Appropriate correction is required.

2. This application has been filed as a continuation under 37 CFR 1.53(b). This application is not a proper continuation but instead is a continuation in part. Evidence of this is the specification requires two separate and distinct parent applications to provide an enabling specification for the claimed invention. Since this application should have been filed under CIP papers it is required that a proper CIP declaration be filed and that the application should be changed to a CIP. See 37 CFR 1.63(e). Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the

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continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

There is insufficient evidence of record that at the time of filing of the individual parent applications applicant had conceived ~~for~~ enabled the combination of the elements of each individual application with each other. Specifically, the Lee patent 5,874,820, application number 08/416,558 discloses a movable reticle stage and a positioning system that controls the position of the object stage with respect to the optic system but '820 does not disclose different frames for supporting the drive system and the optic system and the laser interferometer. Lee patent 5,528,118, application number 08/221,375 discloses a wafer holder, laser interferometer and support stage that is supported separately from a drive stage, but does not disclose a measuring system that measures a position of an object table relative to a sub-system (the optical and exposure system) nor a mask table. The mere fact that two applications existed is not evidence that the combination was conceived or enabled.

This application is deemed to have support for the elements individually from the filing of the parent applications but not for the combination of elements until the filing date of the instant application. The burden of proof in actions relating to an interference must be proven by the requesting party and must be proved to a clear and convincing standard, *Price v. Symsek* 988 F.2d 1187, 26 USPQ2d 1031 (Fed. Cir. 1993).

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.


Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Van Engelen et al. (5,953,105).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Sircus whose telephone number is (703) 308-3119, Monday through Thursday between 8:30 and 5:00 and whose E-mail is brian.sircus@uspto.gov. Please do not send confidential information via e-mail.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

The group fax number is (703) 305-3431 or -3432. Please identify the application number, the examiner, the art unit and a telephone number by which you may be reached on the cover page when sending a fax.

If necessary the examiner's supervisor, Steve Stephan, may be reached at (703) 308-2826.


Brian Sircus
Primary Examiner
June 4, 2000